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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,411	10/12/2001	Amy B. Reed	NPI-30 (14845)	1102

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EXAMINER
VO, HAI

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/976,411	REED ET AL	
	Examiner	Art Unit	
	Hai Vo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *42-68* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *42-68* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. The art rejections have been withdrawn because the Hystretch ® Elastomeric Emulsions" paper is not a proper reference. The copy right notice of 2001-2006 falls before the earliest priority date for the present application (October 13, 2000). Therefore, the paper can not be used to reject features of Applicants' claims. New ground of rejection is made in view of E.W. Flick, "Water-Soluble Resins - An industrial Guide (2nd edition)", 199, pages 163-181.

2. The obviousness-type double patenting rejection has been withdrawn in view of the terminal disclaimer.

Terminal Disclaimer

3. The terminal disclaimer filed on 07/24/2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,887,537 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 42-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al (US 5,191,734) in view of E.W. Flick, "Water-Soluble Resins - An industrial Guide (2nd edition)", 1991, pages 163-181. Weber teaches a biodegradable latex web material as a surgical gown comprising a fibrous web

being saturated with a latex binder having a glass transition temperature from -50°C to 20 °C (abstract). The latex composition is a natural, synthetic or a combination of natural and synthetic polymers as shown in table II. The latex composition comprises a polyacrylate, nitrile rubber, natural rubber or a combination thereof (column 4, lines 31-34, and table II). The latex binder is about 16 to 80 dry parts per 100 parts fibers by weight (column 5, line 29) within the claimed range. Although the glass transition temperature (T_g) of Hycar ®1570X55 is not expressly recited in Weber '734 (table II), US Patent no. 5,370,132 to Weber et al indicates that Hycar ® 1570X55 has a T_g of -48 °C (see table IV of Weber '132). Similarly, Weber '132 evidences that natural rubber Hartex ® 104 having a T_g of -70°C. The latexes of Hycar ®1570X55 and rubber Hartex ® 104 read on Applicants' additional polymer emulsions. Likewise, in accordance with the reference disclosure, it is acceptable and possible to use the latexes having a T_g less than –50°C. Weber does not specifically disclose the use of a polyacrylate latex having a T_g of -20 °C or lower. Flick, however, discloses the hystretch elastomeric latexes as the paper saturants to add durability and resiliency to the paper web (page 181). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use hystretch elastomeric latex as a paper saturant of the Weber product motivated by the desire to add durability and resiliency to the paper web. The examiner notes that Flick also discloses the HYCAR acrylic latex 26146 as a paper saturant having a T_g of –55 °C (page 174). Flick teaches the HYCAR

acrylic latexes stable in processing, compounded easily and containing no solvents to cause flammability or toxicity hazards during processing. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the HYCAR acrylic latex 26146 as a paper saturant of the Weber product motivated by the desire to obtain an ease of the processing. Weber does not specifically disclose the biodegradable latex web material having a Gurley Hill porosity and exhibiting a % BFE as recited in the claims. However, it appears that the biodegradable latex web material of Weber as modified by the Flick is made of the same materials with the similar composition as the medical packaging substrate of the present invention; i.e., paper based web impregnated with a binder present in an amount within the claimed range. The binder has a glass transition temperature within the claimed range. Hence, it is the examiner's position that the Gurley Hill porosity and the percent bacterial filtration efficiency (BFE) would be inherently present. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties.

Applicants assert that although Weber discloses the latexes having a T_g of between –50°C and 20°C, the disclosed polyacrylate latexes have a T_g of -15 °C or greater and non-polyacrylate latexes having a T_g of less than -15 °C. The examiner respectfully disagrees. Polyvinyl chloride of Geon ® 576 as a non-polyacrylate latex has a T_g of 14°C (see page 170 of Flick). Likewise, it is technically incorrect to state that Weber discloses the polyacrylate latexes having

a T_g of -15 °C or greater and non-polyacrylate latexes having a T_g of less than -15 °C. There is a motivation to combine teachings of Weber and Flick and the combination does provide a reasonable expectation of success. Therefore, the combined teachings of Weber and Flick do make out the proper 103 rejection. The BFE is thus an inherent property because it seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. Applicants argue that the phrase "medical packaging substrate" acts as a limitation when read in the context of the present claims. The examiner respectfully disagrees. The preamble "medical packaging substrate" is not considered a limitation and is of no significance to claim construction because (i) the body of claim described a latex saturated paper without the preamble, and (ii) the specification referring "bacterial filtration efficiency" property did not constitute "clear reliance" on the preamble needed to make the preamble a limitation.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai V.

HV

HAI VO
PRIMARY EXAMINER